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CERTIFICATE OF MAILING 37 C.F.R 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below:

January 28, 2000

Date


Shelley P.M. Fussey

Assistant Commissioner for Patents
Washington, DC 20231

RE: *U.S. Patent Application Serial No. 08/951,188; Entitled: "P-TEFb Compositions, Methods and Screening Assays"; David Price (Client Reference: UIRF N7-20)*

Sir:

Enclosed for filing in the above-referenced patent application is:

- (1) A Request (Under MPEP 706.07(d)) to Withdraw Finality of Third Office Action dated January 4, 2000, with claim Exhibit; and
- (2) A return postcard to acknowledge receipt of these materials. Please date stamp and mail this postcard.

WILLIAMS, MORGAN & AMERSON, P.C.

Assistant Commissioner for Patents

January 28, 2000

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Should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Assistant Commissioner is authorized to deduct said fees from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/4200.000200.

Respectfully submitted,



Shelley P.M. Fussey, Ph.D.
Reg. No. 39,458

Encls.

GAU-1652
[Handwritten Signature]

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Date

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Shelley P.M. Fussey

FEB 03 2000

EXPEDITED AFTER-FINAL PROCEDURE
EXAMINING GROUP 1652

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	
David Price	§	Group Art Unit: 1652
Serial No.: 08/951,188	§	Examiner: Tung, P.
Filed: October 15, 1997	§	Atty. Dkt. No.: 4200.000200
For: P-TEFb COMPOSITIONS, METHODS AND SCREENING ASSAYS	§	Former Dkt.: IOWA:012

**REQUEST TO WITHDRAW FINALITY
OF THIRD OFFICE ACTION UNDER MPEP 706.07(d)**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The present document is being filed under MPEP 706.07(d) to respectfully request the Examiner to reconsider and withdraw the holding of finality set forth in the Official Action mailed January 04, 2000 (the "Action"). The Action enters two new grounds of rejection on the basis of two newly-cited prior art documents. The new grounds of rejection are said to have been necessitated by Applicant's amendment, although no specific reasoning to support this allegation is advanced. As claims of the present scope have been pending since the application was filed, the new grounds of rejection are in fact improper and should be withdrawn.

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The first new ground of rejection entered is a rejection of claims 110, 113, 114 and 133-136 under 35 U.S.C. § 102(b) as allegedly being anticipated by the newly-applied Hillier EST reference (see Office Action at page 7, Item 17 and Hillier, GenBank No. T83219). The next new ground of rejection is of claims 110, 113, 114-124 and 133-136 under 35 U.S.C. § 102(b) as allegedly being anticipated by another newly-applied Hillier EST reference (see Office Action at page 8, Item 18 and Hillier, GenBank No. T90767). For procedural purposes, these new grounds of rejection will be treated together.

The Action makes only a cursory reference in an attempt to support finality, alleging that "Applicant's amendment necessitated the new ground(s) of rejection" (Action at page 8, Item 18). There is absolutely no reasoning set forth to support this statement or to explain precisely what amendments are alleged to have necessitated the new grounds of rejection.

In contrast, the record clearly shows that claims with the same or broader scope as the newly-rejected claims have been pending throughout examination (see attached Claim Exhibit). Specifically, the newly rejected claims recite isolated nucleic acid molecules encoding polypeptides that comprise a contiguous sequence of at least about 16, 18, 20, 25, 30, 40, 50, 60, 70, 80, 90 or about 100 amino acids from SEQ ID NO:4, SEQ ID NO:45, SEQ ID NO:47 or SEQ ID NO:50. The claims pending before the Second Office Action recited isolated coding regions encoding polypeptide subunits including a contiguous sequence of at least about 10, 14, 20, 30, 50 or about 100 amino acids from SEQ ID NO:4, SEQ ID NO:45, SEQ ID NO:47 or SEQ ID NO:50. The original independent claim in the case recited isolated coding regions encoding polypeptide subunits including a contiguous sequence of at least about 7 amino acids from SEQ ID NO:4, SEQ ID NO:45, SEQ ID NO:47 or SEQ ID NO:50. There is no reason

advanced as to why the newly-cited art could not have been applied in either the first or the second Office Actions.

Accordingly, it is respectfully submitted that the present holding of finality is premature and it is respectfully requested that it be withdrawn. Should the present Request be denied, Applicant intends to Petition the Group Director under MPEP 706.07(c) and 1002.02(c). Applicant further respectfully requests urgent attention to this matter as the premature finality is hampering the timely progress of this case.

According to MPEP 706.07(d), the present document need only be a Request and not a Petition. Accordingly, no fees should be due. Should any fees be deemed necessary, Applicant respectfully requests a telephone call to Applicant's undersigned representative to discuss deduction from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/4200.000200.

Respectfully submitted,



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Agent for Applicant

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Date: January 28, 2000